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Walter M. Bain

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EXAMINER

SHAPIRO, JEFFERY A

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WALTER M. BAIN

Appeal 2008-2809
Application 10/755,849
Technology Center 3600

Decided: April 23, 2009¹

Before, HUBERT C. LORIN, DAVID B. WALKER, and BIBHU R.
MOHANTY, *Administrative Patent Judges*.

MOHANTY, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

The Appellant seeks our review under 35 U.S.C. § 134 of the final rejection of claims 60-112 which are all the pending claims in the application. Oral arguments were presented on April 7, 2009. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF THE DECISION

We AFFIRM.

THE INVENTION

The Appellant's claimed invention is directed to a system which allows patients to pick up medication when a pharmacy is closed, or busy, while maintaining security measures to ensure that medications are distributed to the appropriate patient (Spec. 3:6-10). The medication distribution system includes a patient interface portion and a medication holding portion. (Spec. 6:10-17). Claim 81, reproduced below, is representative of the subject matter on appeal.

81. A method for dispensing filled prescriptions, the method comprising:

filling a prescription by preparing a container of medication with a label bearing patient information;

loading the filled prescription into an automated prescription dispensing system disposed so as to be accessible from both sides of a pharmacy wall, one side inside the pharmacy being configured for loading prescriptions into the automated prescription dispensing system, and another side being configured for dispensing the filled

prescription to the public on the opposing side of the pharmacy wall;
and

dispensing the filled prescription to a customer outside the
pharmacy wall in response to information input by a person;

wherein the method further comprises requiring multiple pieces
of information associated with a patient and verifying at least one of
patient information and prescription information with the person prior
to dispensing the filled prescription.

THE REJECTIONS

The Examiner relies upon the following as evidence in support of the
rejections:

Schlamp	US 5,385,265	Jan. 31, 1995
Williams	US 5,597,995	Jan. 28, 1997
Liff	US 5,713,485	Feb. 3, 1998

The following rejections are before us for review²:

² We note the Examiner's Answer is inconsistent in identifying which rejections are the subject of this Appeal. The Appeal Brief at page 12 lists and identifies the same rejections that were listed in the Final Rejection of March 6, 2006. In the Examiner's Answer at page 2, item 6, the Examiner states that the Appeal Brief correctly identifies the grounds of rejection. In contrast, the Examiner's Answer at pages 3-10, a different grounds of rejection is then identified. In the Examiner's Answer in the Response to Argument section at pages 10-16 the Examiner's remarks are directed to the same rejections made in the Appeal Brief. The Examiner's Answer at pages 3-10 is therefore considered to be in error in listing the rejections of the claims. The rejections made in the Final Rejection of March 6, 2006 are therefore considered to be the rejections before us for review.

1. Claims 60-80, 93, and 95-112 are rejected under 35 U.S.C. § 103(a) as unpatentable over Williams, Schlamp, and Liff.
2. Claims 81-94 are rejected under 35 U.S.C. § 103(a) as unpatentable over Williams and Schlamp.

THE ISSUE

At issue is whether the Appellant has shown that the Examiner erred in making the aforementioned rejections.

With regards to claims 60-80, 93, and 95-12, this issue turns on whether it would have been obvious to combine Williams, Schlamp, and Liff to meet the claimed limitations.

With regards to claims 81-94, this issue turns on whether it would have been obvious to combine Williams and Schlamp to meet the claimed limitations.

FINDINGS OF FACT

We find the following enumerated findings of fact (FF) are supported at least by a preponderance of the evidence³:

FF1. Williams discloses an automated medical prescription fulfillment system for dispensed drug products (Title, Abstract).

³ See *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Patent Office).

FF2. Williams discloses work stations for imaging, filling, and checking the dispensed drug product (Title, 3:10-63).

FF3. Williams discloses that when the order is complete the pharmacist packages the orders and puts them into a second-prescription holding component 384 (Col. 10:48-53).

FF4. Williams discloses that when the customer comes to the pharmacy for pickup, the sales clerk goes to the proper holding slot or bin 386 of prescription holding component 384 and picks up the order. The order is scanned to verify the customers name and drugs prescribed and if correct given to the customer (Col. 10:53-62).

FF5. Williams does not disclose the customer picking up the prescription from the holding compartment 384.

FF6. Schlamp discloses a vending machine in which the items can be deposited in compartments 11 and removed from openings 4 (Fig. 1). The vending machine includes an input device 8 for identification codes (Fig. 1).

FF7. Schlamp discloses that the customer can withdraw the goods after entering an identification code (Abstract).

FF8. Liff discloses an automated drug dispensing system with a cabinet to store a variety of prepackaged pharmaceuticals in bins for filling patient prescriptions (Abstract).

FF9. Liff discloses that a medical professional can fill the prescription using a computer 46 which transmits the request to a controller 42 located in the cabinet 20. The released package 74 is made available for transfer to the patient (Col. 4:54-Col. 5:2). A bar code reader 40 reads the dispensed

package and informs the user when the dispensed package matches that request made by the user (Col. 5:2-7).

FF10. Liff discloses an embodiment where the prescription can be dispensed directly to the patient using a card reader 38 (Col. 5:14-16).

FF11. Liff discloses that upon validating the bar code 98 on the dispensed package that a printer 54 generates additional instructions for the patient or practitioner (Col. 5:26-31).

FF12. Liff discloses that sensors are used to detect package jams and when the column is empty (Col. 5:8-14).

PRINCIPLES OF LAW

Principles of Law Relating to Obviousness

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18, (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

In *KSR*, the Supreme Court emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *id.* at 415-16, and discussed circumstances in which a patent might be determined to be obvious. In particular, the Supreme Court emphasized that “the principles laid down in *Graham* reaffirmed the ‘functional approach’ of *Hotchkiss*, 11 How. 248.” *KSR*, 550 U.S. at 415, (citing *Graham*, 383 U.S. at 12 (emphasis added)), and reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” The Court also stated “[i]f a person of ordinary skill can implement a predictable variation, § 103 likely bars its patentability.” *Id.* at 417. The operative question in this “functional approach” is thus “whether the improvement is more than the predictable use of prior art elements according to their established functions.” *Id.*

The Court noted that “[t]o facilitate review, this analysis should be made explicit.” *Id.* at 418 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). However, “the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *Id.*

Principles of Law Relating to Secondary Considerations

In our determination of obviousness under 35 U.S.C. § 103, we also carefully weigh, in addition to the evidence relied upon by the Examiner, the objective evidence of nonobviousness provided by Appellant. To be given substantial weight in the determination of obviousness or nonobviousness, evidence of secondary considerations must be relevant to the subject matter as claimed, and therefore the examiner must determine whether there is a nexus between the merits of the claimed invention and the evidence of secondary considerations. *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 305 n.42 (Fed. Cir. 1985), *cert. denied*, 475 U.S. 1017 (1986). In particular, an applicant asserting secondary considerations to support its contention of nonobviousness bears the burden of proof of establishing a nexus between the claimed invention and evidence of secondary considerations. For example, in the case of evidence of commercial success, the Federal Circuit has acknowledged that the applicant bears the burden of establishing a nexus, stating:

In the ex parte process of examining a patent application, however, the PTO lacks the means or resources to gather evidence which supports or refutes the applicant's assertion that the sale constitutes commercial success. *C.f. Ex parte Remark*, 15 USPQ2d 1498, 1503 (Bd. Pat. App. & Int. 1990)(evidentiary routine of shifting burdens in civil proceedings inappropriate in ex parte prosecution proceedings because examiner has no available means for adducing evidence). Consequently, the PTO must rely upon the applicant to provide hard evidence of commercial success.

In re Huang, 100 F.3d 135, 139-40 (Fed. Cir. 1996). *See also In re GPAC*, 57 F.3d 1573, 1580 (Fed. Cir. 1995); *In re Paulsen*, 30 F.3d 1475, 1482 (Fed. Cir. 1994) (Evidence of commercial success of articles not covered by the claims subject to the obviousness rejection was not probative of nonobviousness).

Objective evidence of nonobviousness, including commercial success, must be commensurate in scope with the claims. *In re Tiffin*, 448 F.2d 791 (CCPA 1971) (evidence showing commercial success of thermoplastic foam “cups” used in vending machines was not commensurate in scope with claims directed to thermoplastic foam “containers” broadly). In order to be commensurate in scope with the claims, the commercial success must be due to claimed features, and not due to unclaimed features. *Joy Technologies Inc. v. Manbeck*, 751 F. Supp. 225, 229 (D.D.C. 1990), *aff’d*, 959 F.2d 226, 228 (Fed. Cir. 1992) (Features responsible for commercial success were recited only in allowed dependent claims, and therefore the evidence of commercial success was not commensurate in scope with the broad claims at issue.) An inventor’s opinion as to the purchaser’s reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed invention. *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996). Further, gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015 (Fed. Cir. 1985), or as to the time period during which the product was sold, or as to what sales would normally be expected in the market, *Ex parte Standish*, 10 USPQ2d 1454 (BPAI 1988).

Establishing long-felt need requires objective evidence that an art-recognized problem existed in the art for a long period of time without solution. In particular, the evidence must show that the need was a persistent one that was recognized by those of ordinary skill in the art. *In re Gershon*, 372 F.2d 535, 539 (CCPA 1967). The relevance of long-felt need and the failure of others to the issue of obviousness depend on several factors. First, the need must have been a persistent one that was recognized by those of ordinary skill in the art. *Orthopedic Equipment Co. v. All Orthopedic Appliances, Inc.*, 707 F.2d 1376 (Fed. Cir. 1983); *see also In re Gershon*, 372 F.2d 535, 539 (CCPA 1967). Second, the long-felt need must not have been satisfied by another before the invention by applicant. *Newell Companies v. Kenney Mfg. Co.*, 864 F.2d 757, 768 (Fed. Cir. 1988) (“[O]nce another supplied the key element, there was no long-felt need or, indeed, a problem to be solved.”) Third, the invention must in fact satisfy the longfelt need. *In re Cavanagh*, 436 F.2d 491 (CCPA 1971). “[L]ong-felt need is analyzed as of the date of an articulated identified problem and evidence of efforts to solve that problem.” *Texas Instruments, Inc. v. ITC*, 988 F.2d 1165, 1178 (Fed. Cir. 1993).

As secondary evidence, more than the mere allegation of copying is needed to make a showing of nexus and nonobviousness. “[M]ore than the mere fact of copying by an accused infringer is needed to make that action significant to a determination of the obviousness issue” *Cable Electric Products, Inc. v. Genmark, Inc.* 770 F.2d 1015, 1028 (Fed. Cir. 1015). “Rather than supporting a conclusion of obviousness, copying could have occurred out of a general lack of concern for patent property, in which case

it weighs neither for nor against the nonobviousness of a specific patent” *Id* at 1028.

ANALYSIS

Claims 60-80, 93, and 95-112

The Appellant argues the rejection of claim 60 under 35 U.S.C. § 103(a) as unpatentable over Williams, Schlamp, and Liff is improper because the Examiner has failed to present a prima facie case of obviousness (Br. 15). The Appellant argues that neither Williams or Liff provide any suggestion of using an automated dispenser for dispensing filled prescriptions directly to a patient (Br. 16). The Appellant argues that Liff would require the patient to scan the container of medication and receive a printed label with prescription information (Br. 16). The Appellant argues that there is no teaching that Schlamp could be used to dispense controlled substances, such as prescriptions, and the mere fact that Schlamp discloses a vending device is inadequate (Br. 17). The Appellant argues that the Examiner has failed to identify any teaching of loading filled prescriptions into a dispensing device (Br. 19).

In contrast, the Examiner has determined that the combination of the teachings of Williams, Schlamp, and Liff support a prima facie case of obviousness. The Examiner has determined that Williams teaches placing filled prescriptions in a will call area, and that Schlamp teaches the use of a vending device with a bin door facing the merchant and another bin door facing the customer (Ans. 11-12). The Examiner has determined that Schlamps apparatus would have been used with Williams’s system for

“efficient, automated, fast, economical, and effective pharmacy system”

(Ans. 12).

We agree with the Examiner. Williams discloses a medical prescription fulfillment system for dispensed drug products (FF1). Williams discloses that the pharmacist packages and puts prescriptions into a holding bin 384 (FF3). Williams discloses that when the customer comes to the pharmacy for pickup, the sales clerk goes to the proper bin 384, picks up the order, and if correct gives it to the customer (FF4). Williams does not disclose the customer picking up the prescription from the holding bin 384 (FF5). Schlamp discloses a vending machine in which the items can be deposited in compartments 11 and removed from openings 4 (FF6). Schlamp discloses that the customer can withdraw the goods after entering an identification code (FF7). Liff discloses an embodiment where the prescription can be dispensed directly to the patient using a card reader 38 (FF8).

The modification of the pharmacy system of Williams to include a vending system which required identification codes as taught by Schlamp in view of the teaching of Liff which shows that prescriptions can be dispensed directly to a patient is an obvious, predictable use of prior art elements according to their established functions to obtain a more efficient distribution system for the pharmacy. Schlamp's vending device could be used with any dispensed product and Liff has suggested dispensing pharmacy items by vending equipment. The Appellant argues that Schlamp only requires a customer number and account number, rather than information specifically tied to a patient (Br. 23). However, both a customer

number and an account number would be specifically tied to a customer or patient meeting the claimed limitation. For these above reasons, the rejection of claim 60 under 35 U.S.C. § 103(a) as unpatentable over Williams, Schlamp, and Liff has established a prima facie case of obviousness.

With regard to claims 95-100 and 110 the Appellant argues that the cited references do not disclose the patient and filled prescription being stored electronically (Br. 24). Note that Williams shows a computer system 104 used to track the patient and prescriptions as commonly done in pharmacies. The further tracking of the bin in which the prescription was placed would be an obvious modification to track the physical location of the prescription. For these reasons, a prima facie case of obviousness has been established for these claims.

With regards to claims 62-65 the Appellant argues that the claims further require the dispenser to be disposed in a pharmacy wall (Br. 24). We note that moving the location of the dispenser to a wall to save space, as frequently done in apartments and postal offices, would have been obvious. For these reasons, a prima facie case of obviousness has been established for these claims.

With regards to claim 66 the Appellant argues that the claim further requires that counseling be provided regarding the prescription via the automated dispenser which is not shown in the prior art (Br. 25). We note that prescriptions are often distributed with instructions which broadly serve as written “counseling” meeting the claimed limitations. For these reasons, a prima facie case of obviousness has been established for this claim.

With regard to claims 67-68, 77, and 112 the Appellant argues that the claims require collecting payment for the prescription or billing a insurance provider at the time of sale which is not shown in the prior art references (Br. 25). Note that Williams is a standard pharmacy which would require payment for the prescription and would provide billing to insurance providers. For these reasons, a prima facie case of obviousness has been established for these claims.

With regard to claims 69-74, the Appellant argues that there is no verification of the customers entered information. Verification of the entered information must take place for the product to be vended in the device of Schlamp since it uses identification codes. For these reasons a prima facie case of obviousness has been established for these claims.

With regards to claims 75-76, 78-80, and 93 the Appellant argues that the claims require at least two pieces of information for verification to identify the patient. Note that even a first and last name would serve as “two pieces of information” to verify the customer patient. Regardless, the use of additional items for verification for enhanced security would have been obvious in the combination. For these reasons, a prima facie case of obviousness has been established for these claims.

With regard to claims 103-108, and 111 the Appellant argues that the claims require sensing the location of a filled prescription to verify the location of the prescription, which is not suggested in the prior art references (Br. 28-29). Liff discloses that sensors are used to detect package jams and when the column is empty (FF12). The use of sensors to track the prescriptions and determine if they have been dispensed is considered an

obvious expedient to track the prescriptions. For these reasons a prima facie case of obviousness has been established for these claims.

Claims 81-94

The Appellant argues that the Examiner has erred in rejecting claims 81-94 are rejected under 35 U.S.C. § 103(a) as unpatentable over Williams and Schlamp. With regard to claim 81, the Appellant argues that the prior art does not require the entry of multiple pieces of information or verifying patient or prescription information (Br. 31-32). With regards to claim 82 the Appellant argues that the cited references do not disclose scanning the prescription and sending it to a control unit (Br. 32).

In contrast, the Examiner has determined that the rejection of claims 81-94 under Williams and Schlamp is proper. The Examiner has found that Williams discloses a pharmacy with a will call area and that one of ordinary skill in the art would have found it obvious to be modified with the vending machine of Schlamp to automate the will call area (Ans. 13-14).

We agree with the Examiner. Williams discloses an automated medical prescription fulfillment system for dispensed drug products (FF1). Williams discloses that when the customer comes to the pharmacy for pickup, the sales clerk goes to the proper holding slot or bin 386 of prescription holding component 384 and picks up the order (FF2). Williams does not disclose the customer picking up the prescription from the holding compartment (FF3). Schlamp discloses a vending machine in which the items can be deposited in compartments and removed from openings by the customer after entering an identification code (FF6, FF7). The modification of the pharmacy system of Williams to include a vending

system which required identification codes as taught by Schlamp would have been an obvious, predictable use of prior art elements according to their established functions to obtain a more efficient distribution system.

Schlamp's vending device could be used with any dispensed product. Note that even a first and last name serve as "two pieces of information" to verify the customer patient. With regard to claims 82-83, we note that Williams shows a computer system 104 used to track the patient and prescriptions as commonly done in pharmacies. The further tracking of the bin in which the prescription was placed would have been an obvious modification to track the physical location of the prescription. For these reasons, a prima facie case of obviousness has been established for claims 81-83.

With regard to claim 86, the Appellant argues that the claims require sensing the location of a filled prescription to verify the location of the prescription which is not suggested in the prior art references (Br. 32). The use of sensors to track the prescriptions and determine if they have been dispensed is considered an obvious expedient to track the prescriptions. For these reasons, a prima facie case of obviousness has been established for this claim.

With regard to claims 87-88, the Appellant argues that the prior art does not show using a door to limit access to one side of the dispensing system. The vending device of Schlamp is considered to have walls or doors which limit access to the merchandise. Regardless, the use of a door system as frequently used in apartment mailboxes would have been an obvious substitution if desired to prevent removal of the prescription on both

sides. For these reasons, a prima facie case of obviousness has been established for these claims.

With regards to claims 89-90, the Appellant argues that the prior art does not teach placing a plurality of prescriptions in a single receptacle. Pharmacies frequently place all of patient's prescriptions together to simplify pickup by the patient and such a modification would have been obvious. For these reasons, a prima facie case of obviousness has been established for these claims.

With regards to claim 91, the Appellant argues that the prior art does not suggest dropping the prescription into a trough for access by the customer. Vending machines frequently drop goods into a trough for pickup of items by a customer and such a modification is considered to have been obvious. For these reasons, a prima facie case of obviousness has been established for this claim.

With regards to claim 93, the Appellant argues that the claims require billing an insurance provider which is not shown in the prior art references (Br. 33). Note that Williams is a standard pharmacy which would require payment for the prescription and would provide billing to insurance providers. For these reasons, a prima facie case of obviousness has been established for this claim.

With regards to claim 94 the Appellant argues that the claims require removing the undispensed prescriptions which is not taught by the prior art (Br. 33). The removal of prescriptions which have not been dispensed after some period of time would have been an obvious expedient to free up the

bins for other customers picking up prescriptions. For these reasons, a *prima facie* case of obviousness has been established for this claim.

Secondary Considerations

We recognize that evidence of secondary considerations, such as that presented by the Appellant must be considered in route to a determination of obviousness/nonobviousness under 35 U.S.C. § 103. Accordingly, we consider anew the issue of obviousness under 35 U.S.C. § 103, carefully evaluating and weighing both the evidence relied upon by the Examiner and the objective evidence of nonobviousness provided by the Appellant. “An applicant may rebut a *prima facie* case of obviousness by providing a “showing of facts supporting the opposite conclusion.” Such a showing dissipates the *prima facie* holding and requires the examiner to “consider all of the evidence anew.” *In re Kumar* 418 F.3d 1361, 1368 (Fed. Cir. 2005).

Commercial Success

Turning first to the issue of commercial success, none of the Declaration of William Holmes, videos from Good Morning America and from Channel 8 News, CNN Live at Daybreak transcript, ABC News article, LATimes.com article, or Drug Topics article show any nexus between the claimed invention and commercial success. The Declaration of William Holmes, the owner of the company that owns this patent application, is insufficient to show any nexus between any sales and the claimed invention. An inventor’s opinion as to the purchaser’s reason for buying the product is insufficient to demonstrate a nexus between the sales and the claimed

invention. *In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996). Further, none of the references provide any gross sales figures for the pharmacies as they relate to market share. The references state opinions as to the merits of the invention without providing any sales data whatsoever or any showing of change in market share required to show a nexus between claimed invention and commercial success. Gross sales figures do not show commercial success absent evidence as to market share, *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015 (Fed. Cir. 1985). For these reasons, the Appellant has failed to show a nexus between the claimed invention and commercial success.

Long-Felt Need

Turning next to the issue of long-felt need, none of the Declaration of William Holmes, videos from Good Morning America and from Channel 8 News, CNN Live at Daybreak transcript, ABC News article, LATimes.com article, or Drug Topics article show that there was a long-felt need that was recognized by those in the art, that the long-felt need was not satisfied by another before the invention by the applicant, or that the invention satisfied the long felt need.

Here, the latimes.com article mentions generally that there has been a shortage of pharmacists and that lines in pharmacies have grown long, but none of the other cited references show a persistent need recognized by others in the art as required in the first factor to show long-felt need. Further, none of the references, including the latimes.com article, show that the long-felt need was not satisfied by others before the applicant, or that the

long-felt need was in fact satisfied as required by the second and third factors to show long-felt need. Further there has not been established a date of the articulated problem and evidence of efforts to solve that problem. For these reasons, the Appellant has failed to show a nexus between the claimed invention and long-felt need and the failure of others.

Copying

Turning finally to the issue of copying, none of the Declaration of William Holmes, videos from Good Morning America and from Channel 8 News, CNN Live at Daybreak transcript, ABC News article, LATimes.com article, or Drug Topics article show any evidence between any copying and the nexus of the claimed invention. As secondary evidence, more than the mere allegation of copying is needed to make a showing of nexus and nonobviousness.

Here, the cited references do not even mention any copying of the invention in the marketplace. More than the mere allegation of copying is required to show nonobviousness. For these reasons, the Appellant has failed to show a nexus between the claimed invention and copying.

Obviousness Determination

Having now considered all the evidence presented by the Appellant against obviousness and weighing all the evidence anew, it is our conclusion that the evidence for obviousness greatly outweighs the evidence against obviousness. See *In re Fenton*, 451 F.2d 640, 643 (CCPA 1971) (the court

balanced the Patent Office's case against the strength of Appellant's objective evidence of non-obviousness).

With regard to claims 60-80, 93, and 95-112 the modification of the pharmacy system of Williams to include a vending system which required identification codes as taught by Schlamp in view of the teaching of Liff, which shows that prescriptions can be dispensed directly to a patient is considered to be an obvious, predictable use of prior art elements according to their established functions to obtain a more efficient distribution system for the pharmacy. With regards to claims 81-94 the modification of the pharmacy system of Williams to include a vending system which required identification codes as taught by Schlamp would have been an obvious, predictable use of prior art elements according to their established functions to obtain a more efficient distribution system. The Appellant has failed to show a nexus between the merits of the claimed subject matter and the evidence presented of secondary considerations.

Accordingly, it is our conclusion that the subject matter of claims 60-80, 93, and 95-112 are unpatentable under 35 U.S.C. § 103(a) over Williams, Schlamp, and Liff. Further, it is also our conclusion that the subject matter of claims 81-94 is unpatentable under 35 U.S.C. § 103(a) over Williams and Schlamp.

CONCLUSIONS OF LAW

We conclude that Appellant has failed to show that the Examiner erred in rejecting claims 60-80, 93, and 95-112 under 35 U.S.C. § 103(a) as unpatentable over Williams, Schlamp, and Liff.

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Application 10/755,849

We conclude that Appellant has failed to show that the Examiner erred in rejecting claims 81-94 under 35 U.S.C. § 103(a) as unpatentable over Williams and Schlamp.

DECISION

The Examiner's rejection of claims 60-112 is sustained.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

JRG

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